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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VAN HANDEL, MICHAEL P				
ART UNIT		PAPER NUMBER		
2623				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/006,336

Applicant(s)

DORRICOTT ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 16, 18-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16, 18-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/09/2008 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 6/09/2008. Claims **1-13, 15, 16, 18-35, 37** are pending. Claims **1, 7, 12, 13, 25** are amended. Claims **14, 17, 36** are canceled. Claim **37** is new. The examiner hereby withdraws the rejection of claims **1-13, 15, 16, 18-36** under 35 USC 112, first paragraph, in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding the Watson reference, filed 6/09/2008, have been considered, but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments regarding the application of the Stefik et al. reference to claims **1, 7, 12, 13, and 25**, filed 6/09/2008, have been fully considered, but they are not persuasive.

Regarding claims **1, 7, 12, 13, and 25**, the applicant argues that Stefik et al. does not disclose at least updating the association between a program metadata item and media metadata

data items based on which media items were distributed as a distributed work to a plurality of end users. The examiner respectfully disagrees. The applicant specifically argues that, in Stefik et al., the requester merely records the data and time that the new work was made in the properties of the work or records the contents, data and usage rights, and that the requester is a different data repository from the server, which originates the data.

Stefik et al. discloses a system for controlling the distribution and use of digital works having a fee reporting mechanism. Usage rights are attached directly to digital works. The structure of a digital work, in particular composite works, may be organized into a hierarchy. Portions of the composite work may represent nodes within the hierarchical structure. Consequently, usage rights may be placed on each node by the creator. By enabling control and fee billing to be associated with each node, a creator of a work can be assured that the rights and fees are not circumvented (col. 9, l. 8-20). A description tree for a digital work is comprised of a set of related descriptor blocks (d-blocks). A d-block includes an identifier, which is a unique identifier for the work in the repository, a starting address providing the start address of the first byte of the work, a length giving the number of bytes in the work, a rights portion wherein the granted usage rights and their status data are maintained, a parent pointer for pointing to a parent d-block and child pointers for pointing to the child d-blocks (col. 9, l. 50-52 & Figs. 5-9). The rights portion contains a data structure, wherein the information associated with a right is maintained (col. 9, l. 66-67 & col. 10, l. 1). A special type of d-block is a "shell" d-block, which adds no new content beyond the content of its parts. A shell d-block is used to add rights and fee information, typically by distributors of digital works (col. 10, l. 8-11). The rights portion of a d-block contains status information relating to the state of a right and the digital work (col. 10, l.

24-34, 46-67 & col. 11, l. 1-13). Stefik et al. discloses that transactions between repositories can refer to a part of a digital work, a complete digital work, or a digital work containing other digital works, and that the term “work” is used to refer to whatever portion or set of digital works is being accessed (col. 32, l. 1-6). Each usage rights has one or more conditions which must be satisfied before the right can be exercised. Digital works have parts and parts have parts. Different parts can have different rights and fees. Thus, it is necessary to verify that the requirements are met for all of the parts that are involved in a transaction (col. 32, l. 8-13). When a number of copies right is set, the server repository makes sure the number of copies right will not be violated by performing the transaction. If it will not, the server increments the copies in use value within the status of the right. Likewise, if a metered usage fee was set, the server subtracts the elapsed time from the Remaining-Use-Time field for every part involved with the transaction (col. 33, l. 6-9, 17-22, 48-60 & col. 36, l. 7-15, 44-47; col. 37, l. 29-35, 39-40; & col. 41, l. 23-46). As such, the examiner maintains that Stefik et al. discloses that the server repository maintains and updates the digital rights of the digital works depending on how they have been distributed.

Further regarding claims **1, 7, 12, 13, and 25**, the applicant argues that a repository is extremely unlikely to be operated by an end-user or consumer. The examiner respectfully disagrees. Stefik et al. discloses that repositories have associated user interfaces, which a user uses to interact with a repository in order to invoke transactions to gain access to a digital work (col. 17, l. 21-24). Stefik et al. further discloses that a rendering system comprises a repository (col. 8, l. 24-26). As such, the examiner maintains that the repositories are operated by end-users.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims **15, 16, 18 and 19** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Referring to claims **16 and 19**, the examiner notes that the claims recite a medium by which software is transmitted. Page 4, lines 26-28 of Applicant's specification indicates that a transmission medium may include terrestrial and satellite broadcast (p. 4, lines 2628 of Applicant's specification). As such, it appears that Applicant is claiming a signal, which falls outside all of the statutory categories. See **MPEP 2106** for guidance. Further, claims 15 and 19 the medium could be defined as a signal.

Claim Objections

1. Claims **2, 26** are objected to because of the following informalities:

Referring to claims **2 and 26**, the examiner notes that the phrase "the metadata item" in each of the claims lacks antecedent basis. The examiner fails to find a previous recitation of a "metadata item" in any of claims 1, 2, 25, or 26. The examiner notes that claims 1 and 25 each recite "media metadata items" and a "program metadata item," so it is unclear what is meant by "the metadata item" of claims 2 and 26. The examiner recommends that the phrase be changed to "a metadata item" and interprets the claims in the Office Action below as though the recommended changes have been made.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1-13, 15, 16, 18-35, 37** are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims **1, 12, 15, 16, 19, and 25**, Stefik et al. discloses a system/method for electronic media distribution, the system comprising:

- means for generating a plurality of media items (col. 6, l. 35-40; col. 7, l. 7-8);
- a data repository (col. 7, l. 8-10) for storing respective media metadata items corresponding to multiple media items (col. 9, l. 50-67; col. 10, l. 1-23; & Figs. 5-10), each media metadata item containing metadata relating to the generation of the corresponding media item (col. 10, l. 24-67), said multiple media items being separable and independent from each other (col. 9, l. 9-20, 50-67 & col. 41, l. 23-51);
- means for electronically distributing at least some of the media items to a plurality of end-users (col. 37, l. 52-67 & col. 38, l. 1-20), the distributed media items forming a distributed program having an associated program metadata item (col. 9, l. 9-20, 50-67 & col. 10, l. 3-11);

- means for detecting reception of said distributed media items by the end-users of the distributed program (copies-in-use field)(col. 10, l. 24-67); and
- means for associating, with each media metadata item relating to an electronically distributed media item, a reception indicator indicative of the number of users receiving that media item (copies-in-use field)(col. 10, l. 50-53), wherein a correspondence between said program metadata item and said media metadata items corresponding to said distributed media items is updated at said data repository based on which media items were distributed as said distributed programs to said plurality of end-users (col. 32, l. 1-4, 8-13; col. 33, l. 6-9, 17-22, 48-60; & col. 36, l. 7-15, 44-47; col. 37, l. 29-34, 39-40; & col. 41, l. 23-46).

Referring to claims **2** and **26**, Stefik et al. discloses a system according to claims 1 and 25, respectively, in which a metadata item contains at least metadata relating to the planning or commissioning of the media item (col. 10, l. 65-67 & col. 11, l. 1-6).

Referring to claims **3**, **9**, and **27**, Stefik et al. discloses a system according to claims 1, 7, and 25, respectively, in which the media items include audio and video items (col. 6, l. 35-42).

Referring to claims **4** and **28**, Stefik et al. discloses a system according to claims 1 and 25, respectively, comprising means for associating a material identifying code with each media item for electronic distribution (the examiner notes that usage rights identify that a certain fee is associated with a digital work)(col. 11, l. 44-52 & col. 18, l. 55-65).

Referring to claims **5** and **29**, Stefik et al. discloses a system according to claims 4 and 28, respectively, comprising means for receiving the material identifying codes of media items received by end-users (col. 17, l. 48-67 & col. 18, l. 13-45).

Referring to claims **6** and **30**, Stefik et al. discloses a system according to claims 5 and 29, respectively, in which the receiving means comprises a modem link to the end users' receiving apparatus (col. 18, l. 24-26).

Referring to claims **7**, **13**, and **18**, Stefik et al. discloses a system/method for electronic media distribution, the system comprising:

- means for generating a plurality of media items (col. 6, l. 35-40; col. 7, l. 7-8);
- a data repository (col. 7, l. 8-10) for storing respective media metadata items corresponding to multiple media items (col. 9, l. 50-67; col. 10, l. 1-23; & Figs. 5-10), each media metadata item containing metadata relating to copyright and/or ownership of the corresponding media item (col. 10, l. 24-67), said multiple media items being separable and independent from each other (col. 9, l. 9-20, 50-67 & col. 41, l. 23-51);
- means for electronically distributing at least some of the media items to a plurality of end-users (col. 37, l. 52-67 & col. 38, l. 1-20), the distributed media items forming a distributed program having an associated program metadata item (col. 9, l. 9-20, 50-67 & col. 10, l. 3-11);
- means for detecting the copyright and/or ownership metadata relating to the distributed media items (revenue-owner field)(col. 10, l. 45-67); and
- means for analyzing the distributed media items to determine the content of the media items and generating payment information indicative of a required payment to the holder of rights defined by the copyright and/or ownership metadata based on a determination by the means for analyzing (col. 17, l. 48-67 & col. 18, l. 13-45), wherein a correspondence between said program metadata item and said media

metadata items corresponding to said distributed media items is updated at said data repository based on which media items were distributed as said distributed program to said plurality of end-users (col. 32, l. 1-4, 8-13; col. 33, l. 6-9, 17-22, 48-60; & col. 36, l. 7-15, 44-47; col. 37, l. 29-34, 39-40; & col. 41, l. 23-46).

Referring to claim **8**, Stefik et al. discloses a system according to claim 7, in which the data repository is a database (col. 14, l. 7-39).

Referring to claim **10**, Stefik et al. discloses a system according to claim 7, comprising means for associating a material identifying code with each generated media item, the material identifying code being mapped, in the data repository, to the copyright and/or ownership metadata (col. 10, l. 9, l. 50-67 & col. 10, l. 1, 8-67).

Referring to claim **11**, Stefik et al. discloses a system according to claim 10, in which the detecting means is operable to detect the material identifying code associated with media items to be distributed (col. 36, l. 29-34).

Referring to claims **20** and **31**, Stefik et al. discloses a system according to claims 1 and 25, respectively, further comprising means for logging a distribution time with a transport identifier for a transmitted media item (col. 11, l. 9-13).

Referring to claims **21** and **32**, Stefik et al. discloses the system according to claims 1 and 25, respectively, further comprising means for viewing figures generated at an analysis stage and associated with a metadata item (col. 17, l. 25-29).

Referring to claims **22** and **33**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for assigning different material identifying codes for

different versions of a media item at a time the media item is distributed (col. 18, l. 6-67 & col. 19, l. 1-12).

Referring to claims **23** and **34**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for associating metadata items with each material identifying code recorded for each distributed version of a media item and saving the metadata items with each material identifying code in the data repository (col. 18, l. 54-67 & col. 19, l. 1-10).

Referring to claims **24** and **35**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for monitoring a final version of a distributed media item and subsequently modifying the material identifying code at distribution to include a form in which program is distributed (col. 18, l. 63-65).

Referring to claim **37**, Stefik et al. discloses a system according to claim 1, wherein the media metadata item is a unique metadata identifier (UMID)(col. 9, l. 50-67; col. 10, l. 1-23; & Figs. 5-10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit
2623

MVH